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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,262	12/01/2003	Zach Canizales	CANI/0303	2947

44060 7590 10/05/2005

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EXAMINER	
ROSSI, JESSICA	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/725,262	CANIZALES ET AL.	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *1-15 and 27-33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 27-33, drawn to a laminated deck, classified in class 280, subclass 87.042.

II. Claims 9-26, drawn to a method a method for manufacturing a skateboard deck, classified in class 156, subclass 242.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product could be made by a process where heat and pressure are applied but not vacuum.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: upon election of **Group II**, a further species election must be made.

Species A (appears to be claims 9-15), drawn to layers of resin between the layers of graphite cloth as disclosed on p. 10, line 1 – p. 11. line 11.

Species B (appears to be claims 16-26), drawn to the graphite cloth layers already having the resin therein as disclosed on p. 11, line 13 – p. 13, line 34.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Applebaum on 7/18/05 a provisional election was made with traverse to prosecute the invention of Group II and Species B, claims 16-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 and 27-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

7. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 16-23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renard et al. (US 2002/0064640) in view of Valleau et al. (US 5028100).

With respect to claim 16, Renard teaches making a skateboard deck (sections [0004, 0117]) by forming a first layer of cloth and impregnating the same with resin, applying a second layer of the resin-impregnated cloth to the first layer, repeating the steps of forming and applying

until a desired number of layers are used to form a desired thickness (note layers 3_1, 3_2, 3_3...or layers 4_1, 4_2, 4_3...in Figure 1 and sections [0030-0036, 0077]), inserting the desired thickness of cloth layers into a mold, and subjecting the mold to heat and vacuum for a time sufficient for the resin to cure (skilled artisan would have appreciated that vacuum molding involves a mold, heat and vacuum; sections [0105, 0107, 0112, 0114, 0124]). The reference is silent as to the cloth being graphite cloth.

The reference teaches the cloth layers can be made from a variety of fiber materials including, but not limited to, carbon fibers, glass fibers, metallic fibers, etc. and mixtures thereof (sections 0048-0054]). One reading the specification has a whole would have appreciated that the particular fibers used for the cloth layers is not particularly important so long as the fibers provide the necessary mechanical strength (abstract and section [0030]).

It is known in the art to make a skateboard deck from resin-impregnated cloth layers, where the cloth layers are made from graphite fibers instead of other commonly used fibers, such as glass fibers, because the graphite fibers offer superior strength, stiffness, dimensional stability toughness, low-weight and low cost, as taught by Valleau (column 1, lines 29-33 and 47-58; column 2, lines 1-2 and 6-7).

Therefore, it would have been obvious to the skilled artisan to use graphite fibers for the cloth layers of Renard because such is known in the skateboard deck art, as taught by Valleau, where such a material offers superior strength, stiffness, dimensional stability toughness, low-weight and low cost – especially in light of the fact that Renard teaches the fibers can be carbon and/or metal fibers and graphite is derived from carbon and exhibits metallic properties.

Regarding claims 17-23, selection of process parameters such as heating temperature, vacuum pressure, curing time, etc. would have been within purview of the skilled artisan depending on a combination of factors such as materials used, thickness of the deck, etc.

Regarding claim 25, selection of the number of layers in the deck would have been within purview of the skilled artisan where it would have been readily obvious to the skilled artisan to base such a selection on the conditions under which the deck will be used (i.e. would not want to make a deck too thick, and hence too heavy, otherwise limit users ability to perform stunts).

Regarding claim 26, the use of mathematical equations and/or functions to determine/optimize the number of layers in a laminate is well known and conventional in the composite art.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Renard et al. and Valleau et al. as applied to claim 17 above, and further in view of Moore (US 4295656).

Regarding claim 24, Renard is silent as to an additional layer comprising fiberglass and the resin being used for the deck bottom. It is known in the skateboard deck art to mold a plurality of layers to form a skateboard deck "core" and then apply resin-impregnated fiberglass layers to the top and bottom of the "core" to achieve tapered wing sections that retain lateral flexibility for turn radius control, as taught by Moore (abstract; column 4, lines 10-12 and 16-18 and 27-31 and 44-55).

Therefore, it would have been obvious to the skilled artisan to apply a resin-impregnated fiberglass layer to the bottom of the molded deck of Renard because such is known in the skateboard deck art, as taught by Moore, where this achieves tapered wing sections that retain lateral flexibility for turn radius control.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom G. Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
Primary Examiner
Art Unit 1733